

REMARKS

Claims 1, 3 to 7, 9 to 19, 21 and 23 were pending in the application at the time of examination. Claims 1, 3 to 7, 9 to 19, 21 and 23 stand rejected as obvious.

Claims 1, 7, 19, 21 and 23 are amended. As explained more completely below, each amendment simply recites a feature that was inherent in the original claim language when the claim language was interpreted in view of the specification, as required by the MPEP. Accordingly, the amendments do not require a new search or consideration of new issues. Claim 13 is amended to include a limitation of Claim 14 to further define the file navigation dialogue window, and Claim 14 is amended in view of the amendment to Claim 13.

Applicants disagree with the Examiner's comments. In particular, when folders are displayed in a hierarchical relationship, as in Yagi, the folders must be stored in a way such that they can be accessed via the tree hierarchy. The particular way the tree hierarchy is implemented, pointers, etc. is not important, because given a point in the tree that is represented by a folder icon, the file must be stored at the location associated with that folder icon in the tree, which is a defined storage location otherwise the tree hierarchy would not be functional. As previously pointed out and as explained in the specification, an advantage of Applicants' invention is that the folders in the list do not have to be in any hierarchical relationship and so this saves the user from having to drill down the tree to find the desired folder--one folder could be near the top of the hierarchy, while another folder could be in a completely different tree, or a different part of the same tree, for example. To move the prosecution forward, Applicants clarified the language in the claims as described above.

Claims 1, 4-5, 7, 10-11, 19, 21, and 23 stand rejected as obvious over U.S. Patent No. 6,393,429, hereinafter Yagi, in view of U.S. Patent No. 6,466,238, hereinafter Berry.

Applicants respectfully traverse the obviousness rejection of independent Claims 1, 7, 19, 21, and 23. The Examiner has previously admitted that

As shown in figure 9(B), the **folder tree is a hierarchical list** of all the folders and files on the user's computer. (Emphasis added.)

Accordingly, the record demonstrates that Yagi fails to suggest or disclose

a first section comprising a list of predefined default directories wherein there is no required predefined hierarchical relationship between said predefined default directories in said list

The Examiner cited to Col. 2, lines 13 to 62 of Berry that stated in part:

To address these and other problems, the inventors devised an operating system which, rather than relying on application programs to set a common folder for default document storage, provides a common default folder to all application programs using the operating system. Moreover, for convenient access to the common default folder, some forms of the operating system include a graphical user interface which provides one-button access to the default folder at the highest level of the interface, eliminating the need for users to search through a hierarchical list of folders for the default folder. Additionally, other versions of the operating system includes a service that not only provide a list of most-recently-used documents but also one-button access to the common default folder. (Emphasis Added.)

Berry, Col. 2, Lines 48 to 61.

This teaches a single folder for default document storage, and an ability to access this single folder via one button and so fails to teach or suggest anything concerning "a list of predefined default directories."

The Examiner also cited to Berry, Col. 9, lines 26-42, which stated:

A fourth way of providing convenient access to the My Documents folder is to provide a link the folder in a list of most-recently-used documents. For example, FIG. 4D shows a Start menu 112 which has been invoked on desktop 106 to show a Documents submenu 112a. A section 112b of the submenu. includes a list of most-recently-used documents which includes a link 112c to the My Documents folder. Thus, if the list lacks a particular documents that a user wants to access, the user may easily check the My Documents folder for it. In addition, this most-recently-used documents feature is also included within a file-open dialog window. Those of skill in the art, however, will understand that this augmented most-recently-used documents list may be placed anywhere in the graphical user interface. (An extension to this approach is to supplement or substitute the list of most-recently-used documents with a list of most-recently-accessed document folders.) (Emphasis Added.)

This section teaches that the My Document folder instead of being accessed via the button described above can be accessed from a link in list of most-recently-used documents, which apparently would be element 86 in Fig. 9B of Yagi.

Despite the explicit teaching that a single folder and ways to access that single folder are being described by Berry, the Examiner further stated:

It would have been obvious . . . to modify the file navigation window taught by Yagi to include a section comprising the default folder of Berry. It would have been advantageous . . . to utilize such a combination because if the pre-specified and recently accessed files and folders of the dialog window lack the document desired by the user, such a default folder may be easily checked to access the document.

Applicants note that the motivation given by the user is not supported by any teaching or reference to the prior art. Moreover, the motivation fails to relate to Applicants' inventions as recited in the claims. In addition, the My Documents folder teaches or suggests nothing about

a first section comprising a list of predefined default directories wherein there is no required predefined hierarchical relationship between said predefined default directories in said list

The My Documents folder is not "a list of predefined default directories." Since the record demonstrates that Yagi fails to teach or suggest such a first section and the My Documents is not such a section. Even if the combination of references were appropriate, the combination fails to suggest or disclose Applicants' invention as recited in Claims 1, 7, 19, 21, and 23. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 7, 19, 21, and 23.

Claims 4 and 5 depend from Claim 1 and so distinguish over the combination of references for at least the same reasons as Claim 1. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 4 and 5.

Claims 10 and 11 depend from Claim 7 and so distinguish over the combination of references for at least the same reasons as Claim 7. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 10 and 11.

Claims 3, 6, 9, and 12 stand rejected as being obvious in view of Yagi and Berry taken with U.S. Patent No. 6,370,549, hereinafter Saxton. Assuming that the combination of references is correct, the additional information relied upon by the Examiner from the secondary reference fails to overcome

the basic deficiency of the two primary references as noted above with respect to the independent Claim. Accordingly, Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 3, 6, 9, and 12

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Windows NT 4.0, as described by Jacquelyn and Joseph Moran in the book entitled How to Use Windows NT 4 Workstation and also over Yagi.

Applicants respectfully traverse the obviousness rejection of Claim 13. As best understood, the Examiner considers the Windows NT 4.0 Explorer initial interface to be a file open window and one of the folders listed in the hierarchical folder list to be a file navigation icon. The Examiner is correct that on a first action, e.g., a left click of the mouse, on that folder results in contents of the folder being displayed in another window. However, it is well-known in the art that when a second action, e.g., a right click of the mouse, is performed on the same folder that a menu of options is presented. Applicants do not have the complete reference cited by the Examiner available but include as Exhibit 1, the title page, the copyright right page, and page 74 of Mastering Windows NT Workstation. This page defines the right click menu for the folder icon.

The MPEP requires that a modification of a prior art reference

**THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART
UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP § 2143.01, Eighth Edition, Rev. 2, p 2100-131, (May 2004).

The Examiner's proposed modification of the prior reference would change the functionality of the primary reference, i.e., the Windows NT operating system, and render the prior art unsatisfactory for its intended purpose with respect to the right click functionality. Therefore, according to the MPEP there is no suggestion of motivation to make the proposed modification. If the Examiner continues the rejection, the Examiner is requested to explain, how Windows NT 4.0 operating system would continue to function for its intended purpose on the right click action after the proposed changing of the functionality.

Moreover, even if the combination were correct. The material relied upon in Yagi fails to suggest or disclose the file navigation window as recited in Claim 13. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 13.

Claims 14, 16, and 17 stand rejected as obvious in view of Windows NT, Yagi, and Berry. The above comments on the combination of the primary references with respect to Claim 13 are incorporated herein by references. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 14, 16, and 17.

Claims 15 and 18 stand rejected as obvious in view of Windows NT, Yagi, Berry, and Saxton. The above comments on the combination of the primary references with respect to Claim 13 are incorporated herein by references. Applicants request reconsideration and withdrawal of the obviousness rejection of Claims 15 and 18.

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Claims 1, 3 to 7, 9 to 19, 21, and 23, remain in the application. Claims 1, 7, 13, 14, 19, 21 and 23 are amended. Claims 2, 8, 20, 22, and 24 were previously canceled. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 4, 2004.



Attorney for Applicant(s)

October 4, 2004

Date of Signature

Respectfully submitted,



Forrest Gunnison
Attorney for Applicant(s)
Reg. No. 32,899
Tel.: (831) 655-0880